

REMARKS

Upon entry of the present amendment, claims 1-8 will remain pending in the above-identified application and stand ready for further action on the merits.

The amendments made herein to the claims do not incorporate new matter into the application as originally filed. The amendments simply serve to more particularly set forth the inventive discovery by deleting tungsten and molybdenum metal compounds formed with group Vb elements.

Entry of the instant amendment is respectfully requested as it removes issues for appeal and/or only requires only a cursory review by the examiner, and at the same time helps to properly and distinctly set forth what Applicants regard as their inventive discovery.

Claim Rejections Under 35 USC § 102(b)/103(a)

Claims 1-8 have been rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as being obvious over Krabetz et al. (US 4,925,823). Reconsideration and withdrawal of this rejection is requested based upon the following considerations.

Preliminary Comments

At page 4 of the outstanding office action, the Examiner references the language "consisting essentially of" as being present in claims 1-2. This is wrong, as claims 1-2 previously did not, and currently do not, contain the transitional phrase "consisting essentially of".

Distinctions Over the Cited Art

In the instantly amended claims, elements used in the inventive oxidation catalyst compositions have been limited so that tungsten and molybdenum metal compounds formed with elements of group Vb are no longer recited therein.

In contrast to the present invention, the catalyst of Krabetz et al. requires Sb, and As or Cu, or both, also as essential elements, since "c" is more than zero (0) and "d + e" is more than zero (0), as disclosed at column 2, lines 6-20 of Krabetz et al. As such, it follows that the presently claimed invention is completely novel, and not anticipated by the disclosure of Krabetz et al.

Notably, the presently claimed compositions, which do not contain essential elements taught by Krabetz et al., are useful for the oxidation of olefin compounds. In contrast, as noted previously, the catalyst of Krabetz et al. are suitable for the

oxidation of arolein to acrylic acid with oxygen as an oxidating agent.

Accordingly, based upon the above noted differences between the constituting elements of the disclosed catalyst of the present invention, and those of the cited art of Krabetz et al., as well as the difference in reactivities of the catalyst, it is apparent that those of ordinary skill in the art would not in any way be motivated to arrive at the present invention as claimed, based on the teachings and disclosure of Krabetz et al. Absent such motivation in the cited Krabetz et al. reference, the outstanding rejection under 35 USC § 103(a) cannot be sustained.

As set forth in § 2143.01 of the Manual of Patent Examining Procedure (MPEP):

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other

modification." In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Accordingly, it is submitted that each of the outstanding anticipation and obviousness rejections based on the disclosure of Krabetz et al. must be withdrawn at present.

CONCLUSION

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims 1-8 are allowed and patentable under the provisions of Title 35 of the United States Code.

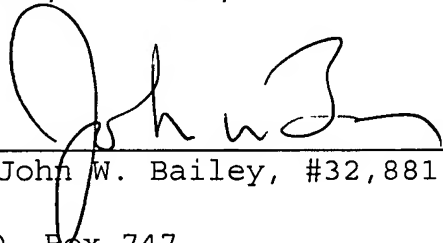
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By


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